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Mailed : 2-7-07
In re Application of : dss
Hermann Wagner et al. : DECISION
Serial No.: 10/829,392 : ON PETITION
Filed : April 22, 2004 :
For: METHOD AND APPARATUS FOR REMOVING :
AN EDGE REGION OF A LAYER APPLIED TO A SUBSTRATE :
AND FOR COATING A SUBSTRATE AND A SUBSTRATE :

This is a decision on a PETITION OF THE RESTRICTON REQUIREMENT UNDER 37 CFR 1.181 filed September 06, 2006 requesting a review of the restriction requirement of the Office action mailed March 10, 2006 and made FINAL in the Office action mailed June 22, 2006.

The application was filed with a total of 43 claims. A restriction requirement was mailed on March 10, 2006 dividing 43 claims into three separate and distinct inventions.

Group I contains claims 1-10,24-31,34-35, and 38-43 drawn to a method classified in class 438.

Group II contains 11-20 drawn to an apparatus classified in class 156.

Group III contains claims 21-23,32-33, and 36-37 drawn to a product classified in class 428.

It is noted that in a restriction requirement, the initial burden is on the Office to establish a *prima facie* case that (a) the claimed inventions are independent or distinct and (b) there would be a serious or undue burden on the examiner if restriction were not required. See MPEP 803.

With respect to (a) above, the examiner's basis for the restriction was that claims 1-10,24-31,34-35, and 38-43 are drawn to a method; claims 11-20 are drawn to an apparatus; and claims 21-23,32-33, and 36-37 are drawn to a product. And, with respect to (b) above, it was indicated that the inventions had acquired a separate status in the art as shown by their different classification. See page 2 of the action mailed March 10, 2006.

Applicant's response was to elect Group I with traverse. The traversal was on the grounds that the restriction there is no convincing evidence of sufficiently distinct inventions.

Group I is said to be directed to a process whereas Group II is said to be directed to an apparatus for practicing the process of Group I. In the Restriction, it is alleged that the apparatus can be used to practice another materially different process, namely

the removal of contamination from a wafer. Firstly, it is not seen how the asserted hypothetical process is "materially different" as both processes would apparently involve removal of undesired material from a substrate. Secondly, the Restriction does not explain how the apparatus could be used to remove only particles, rather than a layer of material.

As for Groups I and III, the restriction asserts that the process can be used to make another materially different product such as a product wherein a center region of a layer is remove. However, claim 1 of Group I expressly recites that the process involves "removing said edge region by evaporation by means of said laser beam."

With respect to the Restriction between Groups I and II, the Examiner presently argues that "the process as claimed can be practiced by a materially different apparatus, such as a plasma etcher." However, this is incorrect. The claimed method expressly recites that the edge region is removed by a laser beam. The Examiner presents no rationale as to how a plasma etcher can remove an edge region by the use of laser beam. Thus, the Examiner has not shown that the method can be practiced be a materially different apparatus. With respect to the Restriction between Groups I and III, the Examiner presently argues that the product as claimed can be made by a materially different process, such as a plasma etching through a mask. However, the Examiner presents no rationale as to how a plasma etching process will achieve the same type of profile for the removed edge region of the layer. See, for example, applicants' Figure 5a of a profile measurement of an edge region that has been removed in accordance with the claimed method. Thus, the Examiner has not shown that the product can be made be a materially different process.

With respect to applicants' argument, it is noted that under MPEP 806.05(e) the examiner is required to state that either that the process as claimed can be practiced by another materially different apparatus or by hand; or that the apparatus as claimed can be used to practice another materially different process. However, the examiner is not obligated to provide documentation. In the action mailed March 10, 2006, the examiner set forth a materially different process, such as removing particulate contamination from a wafer, and in the action mailed June 22, 2006 the examiner described a materially different apparatus such as a plasma etcher. Applicants argue that a process of using a plasma etcher would not remove an edge region by a laser beam as recited in the instant process claim. However Argument such is purely conclusionary since no evidence has been shown to indicate why an apparatus equipped with a plasma etcher would not be able to remove an edge region.

With respect to applicants' argument, it is noted that under MPEP 806.05(f) the examiner is required to state that either the claimed process can be used to a materially different product or that a materially different process can yield the claimed product. However, the examiner is not obligated to provide documentation. In the action mailed March 22, 2006, the examiner set forth a process can be used to a materially different product, such as one wherein a removing a center rejoin of a layer applied to a substrate for use in a microlithography process, and in the action mailed June 22, 2006 the examiner described a materially different process such as the products claimed can be made by a materially different process such as, plasma etching a masked area to remove the substrate. Applicants argue that a plasma etching process will not achieve the same type of profile for the removed edge region of the layer. Argument is purely conclusionary since

no evidence has been shown to indicate why a process of plasma etching would not be able to achieve the same type of profile for the removed edge region of the layer.

In view of the above discussion, having weighed both the examiner's position and the applicants' arguments, it is concluded that, on the balance, the restriction is proper.

The petition is DENIED.

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